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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,048	09/15/2000	Robert S. Behl	16807-002400	3396
23639	7590	03/10/2006	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067			ROLLINS, ROSILAND STACIE	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	09/663,048	BEHL ET AL.	
	Examiner	Art Unit	
	Rosiland S. Rollins	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-23 and 25-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-23 and 25-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-23 and 25-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank (6312429) in view of Wampler (US 6165175) and further in view of Mahvi (2002/0022864). In figure 11, col. 9 lines 48-50 and col. 11 line 66 – col. 7 line 1, Burbank discloses a probe for deploying electrode arrays. The probe comprises a shaft, a first array of electrode having a concave face and a second array of electrodes also having a concave face, wherein the concave face of the first and second arrays face each other when the arrays are deployed.

Wampler et al. teach that it is old and well known in the art to construct electrosurgical instruments as bipolar devices by incorporating both the active and return electrodes into the electrosurgical instrument to substantially restrict the flow of current to the tissue that is placed between the electrodes. Wampler et al. also disclose that it is advantageous to use a bipolar device when cutting tissue as is the case with the electrode arrays of Burbank, to ensure that the flow of current is confined to the

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tissue in the instrument and to a significantly lesser extent to the tissue adjacent the instrument.

Mahvi teaches in figures 1-5, paragraphs (0009) and (0038)-(0040) that it is known in the art to couple one pole of a RF power supply to a first electrode array (e.g. 22a, (0039)) and another pole of the RF power supply to a second electrode array (e.g., 22b, (0039)) and energizing the power supply to apply electrical current between the first and second array spaced at opposite edges of a tumor (0038)-(0039).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the electrode arrays of Burbank bipolar based on the Wampler et al. teaching that it is advantageous to use a bipolar device when cutting tissue as is the case with the electrode arrays of Burbank, to ensure that the flow of current is confined to the tissue in the instrument and to a significantly lesser extent to the tissue adjacent the instrument. It would have also been obvious based on the Mahvi teaching that the structural bipolar connection of electrode arrays are old and well known in the art.

Regarding the claim limitations directed to the distance and volume between the electrodes, frequency range and the power range, it would have been obvious to one of ordinary skill in the art at the time the invention was made select the dimensions and ranges as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the prior art.

Response to Arguments

Applicant's arguments filed 11/25/05 have been fully considered but they are not persuasive.

Applicant argues that incorporating Wampler's bi-polar electrosurgery device or Mahvi's ablation electrode into Burbank's respective plurality of locator wires would result in a thermal ablation of the tissue between the locator wires instead of cutting the tissue directly in front of the locator wires. Applicant also states that the proposed modification of Burbank in light of Wampler or Mahvi renders Burbank, unusable for its intended purpose, i.e. securing a trocar and biopsying tissue for histopathological examination.

Wampler is recited for teaching a bi-polar electrode structure. Mahvi is recited for teaching a bi-polar connection of the electrodes to the power supply. A bi-polar electrode structure or a bi-polar connection of electrodes to a power supply does not automatically result in an ablation device as Applicant is suggesting. Wampler clearly discloses a bi-polar cutting device. To conclude that the provision of a bi-polar electrode structure on an electrosurgical device renders the device an ablation device is an inaccurate assessment of the bi-polar electrode technology. While it is agreed that Mahvi does in fact disclose an ablation device, the components of Mahvi that were combined with Burbank are not solely limited to the ablation technology. It is the position of the Examiner that connecting the electrodes of Burbank in a bi-polar manner would not prevent Burbank from cutting tissue as Applicant is suggesting.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

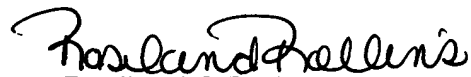
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
Art Unit 3739